

09/691,553  
Art Unit 2154  
Docket 8673

a part of the terminal of Fig 11.", please insert the following:

Figure 14 is a flow chart illustrating processes undertaken by one form of the invention, and undertaken by processes described in claim 39 and others.

#### **REMARKS**

This Request is submitted in response to the Office Action mailed on June 19, 2006. Claims 39 - 47 are pending, and all stand rejected at present.

A PROPOSED DRAWING AMENDMENT is herewith submitted in which Figure 14 is added.

#### **RESPONSE TO 103 - REJECTIONS**

##### **Claim 39**

###### Example of Claimed Subject Matter

A bank may operate a self-service terminal (SST), such as an automated teller machine (ATM). A "Third Party," such as an airline, may present information on the ATM, such as flight schedules. (Specification, page 1, lines 9, 10; page 3, line 6 et seq.)

The bank may wish to allow the airline to use the ATM's printer, to print bonus miles, for example. (Specification, page 16, line 10 et seq.) The invention allows this printing, but without allowing the airline to control the printer, for security

09/691,553  
Art Unit 2154  
Docket 8673

reasons. (Specification, page 17, lines 17 - 25.)

In the language of claim 39, the airline's information is presented by way of a "third party application" ("application" is shorthand for "application program," which is a computer program.) Claim 39 states that the "terminal application" (running on the ATM) determines whether the "request" (the request to print the bonus miles) "should be granted."

If so, then the last paragraph of the claim is performed. The printing is done, but "control of the peripheral device is not passed to the third party application," as claimed.

Elements of Claim not Found in References, Even if Combined  
Part I

Claim 39 states that the user accesses a "third party application" from an SST. The Office Action, page 5, section 9, second paragraph, asserts that Drummond shows this in column 11, lines 6 - 24.

However, this passage of Drummond discusses documents which are stored on a "home HTTP server," and which are delivered to the ATMs for presentation on the ATM's video display. These documents act as advertising to draw customers, since the ATM is in "attract mode" at this time. (Column 10, lines 57 - 61.)

At least three problems exist in the PTO's contention.

09/691,553  
Art Unit 2154  
Docket 8673

#### PROBLEM 1

The claim states that the "option" is for "accessing a third party application" (ie, program).

The documents of Drummond are stored in the "home HTTP server." That is the server which is operated by the bank which operates Drummond's ATMs.

That bank is not a "third party."

#### PROBLEM 2

One problem is that the claim states that the customer of the SST is given "an option of accessing a third party application." But, as just explained, the material which is being sent from the "home HTTP server" is being presented on the ATM in "attract mode." No customer is present. In fact, "attract mode" is used for that very reason: to attract customers.

Thus, with no customer present (or "user" in the terms of claim 39), no "option" can be given to the customer/user.

#### PROBLEM 3

Not only is no "option" presented **to a customer**, but no "option" is presented at all. Drummond states that the material is presented whether a customer is present or not, and he does not discuss any "options" in the passage in question.

Consequently, Applicant requests, under 37 CFR §§ 1.104(c) (2)

09/691,553  
Art Unit 2154  
Docket 8673

and 35 U.S.C. § 132, that the PTO specifically identify the claimed "option" in Drummond.

Further, Applicant requests that the PTO identify the claimed "service" which is obtained by exercising the claimed "option" in Drummond.

Elements of Claim not Found in References, Even if Combined  
Part II

Claim 39 states that the user is given an "option of accessing a third party application" (ie, program) and obtaining a "service" from that "application."

Any "application" in the cited Drummond passage operates to send documents to ATMs which are in "attract mode."

However, no customer/user would interact with that program, the PTO has not identified any interaction, and the Drummond passage does not discuss any such interaction.

Thus, no "option" is present in Drummond, as claimed.

Elements of Claim not Found in References, Even if Combined  
Part III

The last paragraph of claim 39 states that "control of the peripheral device is not passed to the third party application."

Drummond is contrary to this recitation. For example, at column 12, lines 16 - 27, he states that server 92 sends instructions to a card reader, which controls the card reader.

09/691,553  
Art Unit 2154  
Docket 8673

As another example, at column 17, lines 32 - 41, Drummond's server 90 sends a document to the ATM, which is displayed on the ATM's screen. Applicant's Specification, page 9, line 23, states that the display 52 is a "peripheral device." Thus, Drummond's server 90 controls a peripheral device, contrary to the claim.

As a third example, the Drummond-passage cited by the PTO (column 11, lines 6 - 24) states that a "home HTTP server" sends documents to an ATM display. Thus, the server obtains control of the display.

Drummond is contrary to the claim recitation in question.

Elements of Claim not Found in References, Even if Combined  
Part IV

Claim 39 states that a "service" is provided by a "third party application" by way of a "peripheral device" in the SST. Call this Event A.

In addition, claim 39 states that, when the request for this "service" is granted, no control over the "peripheral device" is passed to the third party application. Call this Event B.

Even assuming that Events A and B are shown in the prior art, no showing has been made that Events A and B should occur together.

Restated, even if the references show Events A and B, those Events can be combined in at least three ways:

- 1) Event A occurs **before** Event B,

09/691,553  
Art Unit 2154  
Docket 8673

- 2) Events A and B occur **together**, and
- 3) Event A occurs **after** Event B.

The PTO has failed to show that possibility (2) necessarily follows from the combination of references.

Applicant Submits that Combination of References Makes no Sense  
And, Under Combination, "Third party Application" Disappears

The claim passage just discussed (claim 39, first paragraph) states that the "option" is presented "while the user is at the self service terminal." The Office Action admits that Drummond does not show this presence of the user (Office Action, page 6, first full paragraph), but asserts that Angles does so.

However, Applicant respectfully submits that this addition of Angles makes no sense.

As explained above, Drummond is operating in "attract mode." In "attract mode," no customer is present. Thus, there is no reason to add the user of Angles.

However, if a user, such as one in Angles, is attracted to Drummond's ATM, then, to operate the ATM, the user touches the screen of the ATM. That causes a completely different set of programs to be launched. (Drummond, column 11, line 41 et seq.) Thus, the "application" supposedly found in Drummond, column 11, lines 6 - 24 (which was used to show the "third party application" of the first paragraph of claim 34) has now disappeared.

09/691,553  
Art Unit 2154  
Docket 8673

Consequently, any "service" obtained by the customer (such as obtaining cash) is now obtained from the new programs.

Thus, the "service" of the first paragraph of claim 39 is not obtained from the claimed "third party application." It is obtained from another application. And that other application is not a "third party application." It is the application of the bank which runs the ATM.

No Teaching Given for Combining the References

No valid teaching has been given for combining the references. The rationale given is that the combination allows the user to obtain information "from the application" "while the transaction is in progress." However, several problems exist in this rationale.

PROBLEM 1

The rationale is factually incorrect. The "application" to which the rationale refers is that of Drummond, column 11, lines 6 - 24. That "application" is the program which transmits documents to the ATMs, for display during "attract mode."

But the customer does not interact with that "application," and does not obtain information from that "application" "while the transaction is in progress." As soon as the customer touches the touch screen in Drummond, to start a transaction, a **new program**

09/691,553  
Art Unit 2154  
Docket 8673

presents new information on the screen. The "attract mode" terminates at that time. (Column 11, line 40 et seq.)

Thus, no information is received from the supposed "third party application" during the transaction, as the rationale asserts.

#### PROBLEM 2

The rationale is factually incorrect for a second reason. The customer in Drummond never exercises an "option" as claimed to obtain a "service" from the program in Drummond which transmits the documents to the ATM for display in "attract mode."

#### PROBLEM 3

The combination of references adds the user of Angles to the system of Drummond. It is unclear, as a matter of logic, how addition of Angles' user serves to obtain information "from the application" "while the transaction is in progress."

That is, the Office Action appears to be asserting that the latter operation (obtain information etc.) appears to be present in Drummond, except for the presence of the user. Thus, there is no reason to add the user to obtain that operation.

Consequently, the rationale's assertion that the combination produces that operation, and attainment of that operation is a motivation for making the combination, is invalid. The operation

09/691,553  
Art Unit 2154  
Docket 8673

exists in Drummond, whether or not the user of Angles is added, according to the PTO's reasoning.

#### PROBLEM 4

The references are contradictory, or at least non-analogous art, and cannot be combined.

-- Drummond states that an ATM displays screens in "attract mode."

-- Angles states that, when a user downloads a web site, a request for advertising is inserted into the downloaded web page. When the web page reaches the user's computer, the computer executes the request, by sending a message to another web site, to fetch the advertising, which is then displayed on the user's computer.

These two processes have no relevance to each other.

Further, in Angles, the user selects the initial web page, and then Angles adds advertising to that web page. In Drummond, the PTO has not shown that the user selects any web page at all. The references are contradictory, or at least pursue different goals.

Rejection is Invalid as Matter of Law

#### SUMMARY

09/691,553  
Art Unit 2154  
Docket 8673

The Office Action first asserts that part of claim 39 is obvious, and then that the addition of a Noticed element to this part is obvious. But part of a claim cannot be obvious. This obviousness-upon-obviousness rejection is not allowed.

The rejection is **NOT** asserting that the overall claim is obvious in view of the prior art, as required.

Instead, the rejection asserts that the claim is obvious in view of

- (1) Officially Noticed matter and
- (2) something else which is supposedly obvious.

That approach is invalid. Inventions are obvious based on **prior art references**, not on items which are supposedly "obvious."

Stated more simply, prior art does not include things which are "obvious." One reason is that only "inventions" can be "obvious." The legal definitions of obviousness only apply to inventions, and not to other entities. So there is no way to determine whether other entities are, in fact, "obvious."

#### DISCUSSION

The approach of the rejection is twofold.

- First, Drummond and Angles are combined, to supposedly provide part of claim 39.
- Second, "Official Notice" is taken of the

09/691,553  
Art Unit 2154  
Docket 8673

recitation of not passing control of the peripheral to the third party application. That Noticed subject matter is then added to the combination of Drummond and Angles.

This does not comply with the requirements of section 103.

35 USC § 103 states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 . . .

if the differences between the subject matter sought to be patented and the prior art are such that **the subject matter as a whole would have been obvious** . . .

The rationale does not show that **the subject matter as a whole** is obvious.

Instead, the rationale asserts that (1) part of the claim is obvious for one reason and (2) an addition of another element to that part is obvious for another reason.

That approach does not show that **the subject matter as a whole** is obvious. Even if that approach is factually accurate, it merely shows

-- part of the claim is obvious for one reason, and then  
-- an addition to that part is obvious for another reason.

09/691,553  
Art Unit 2154  
Docket 8673

From another point of view, this approach presupposes that the "part" discussed above lies within the prior art, and the "addition" (the Noticed element) is obvious to add to the "part."

But the "part" is not found within the prior art. Things which are "obvious" are not part of the prior art.

Official Notice is Erroneous

POINT 1

First, the wrong item is "Officially Noticed."

-- The claim states that "control of the peripheral device is not passed to the third party application **when the request is granted**"

-- The PTO asserts that such control is **NEVER** passed in the references cited to support the Notice.

The Noticed subject matter does not correspond to the claimed subject matter.

POINT 2

It will be assumed arguendo that the Noticed subject matter (not passing control "at any time") is sufficiently close to the claimed subject matter of not passing "when the request is granted."

Nevertheless, the recipient (actually non-recipient) which is

09/691,553  
Art Unit 2154  
Docket 8673

denied "control" in the Noticed subject matter does not correspond to the recipient in the claim. In the claim, the recipient denied control is the "third party application," which provides a "service" to the user through a "peripheral device," yet without receiving "control" of the "peripheral device."

The Noticed references do not show such an "application." Ramachandran merely shows a device which dispenses cash and also stamps. The PTO has not shown any "third party application" which operates a peripheral without control, as claimed.

Further, the PTO's assertion is suspect. How could Ramnachandran issue stamps without control of the dispenser ? How does he dispense cash, without control of the dispenser ?

This applies to the other two references.

Thus, the undersigned attorney respectfully traverses the Official Notice, and requests a citation of evidence showing **precisely where** in the three references (Ramachandran, Barrameda, and Waters) the **identically claimed subject matter** is found. (See MPEP § 2144.03.)

Rationale for Combining Noticed Subject Matter is Flawed

POINT 1

The Office Action, page 5, asserted that, in Drummond, a "third party application" operates a "peripheral device." As explained above, that is not correct, because any programs

09/691,553  
Art Unit 2154  
Docket 8673

operating such devices are programs owned by the bank, not a third party. Thus, the rationale's assertion that the combination allows the user to obtain information from the "application" during a "transaction" is factually incorrect. No such "application" is found in Drummond.

#### POINT 2

Assume arquendo that "third party applications" are present in Drummond, and that they operate peripheral devices. The Office Action's rationale asserts that it is obvious for the "third party applications" to operate the "devices" without receiving "control" of the devices.

Applicant points out that no expectation of success has been shown for this. In essence, the Office Action is asserting that the "third party application" controls the peripheral, without control.

That is circular reasoning.

#### POINT 3

No expectation of success has been shown, indicating that the combination of references actually works. MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . .

09/691,553  
Art Unit 2154  
Docket 8673

To establish a *prima facie* case of obviousness, three basic criteria must be met.

. . .  
Second, there must be a reasonable expectation of success.

. . .  
The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

Applicant submits that the PTO must show how the peripheral can be "controlled" without "control."

#### POINT 4

The rationale further states that the addition of controlling-without-control is obvious because it allows "the transaction-related accessing to be finished without" interrupting the "third party application."

Again, no expectation of success has been shown. How does the "third party application" provide the "access" without being interrupted ? That is, if the "application" is doing one thing, and then provides "access," it is necessarily interrupted.

#### POINT 5

The rationale is actually self-defeating. Applicant's Specification explains how a peripheral can be operated by a remote

09/691,553  
Art Unit 2154  
Docket 8673

party, without giving that party control of the peripheral.

The PTO's rationale posits a goal of avoiding interruption of the third party application. But the PTO has not shown **HOW** the "access," or the claimed "service," can be provided to the customer as claimed, without the interruption which is to be avoided.

Therefore, since (1) the PTO seeks to avoid interrupting the third party and (2) the PTO has not shown how the claimed "service" can be provided without the interruption, the PTO's rationale actually leads to provision of **no service** to the customer (to avoid the interruption).

Restated, (1) if the PTO's goal is to avoid interruption, and (2) if the PTO cannot explain how to provide "service" without interruption, then, necessarily, the PTO's reasoning leads to providing no service.

Consequently, the rationale does not lead to the claimed invention, which recites providing the service.

#### **Remaining Claims**

The preceding discussion applies to the remaining claims.

#### **RESPONSE TO 112 - OBJECTIONS**

Support for the objected language of claim 39 is found in the Specification at the following locations, and others:

-- Page 17, lines 17 - 25.

09/691,553  
Art Unit 2154  
Docket 8673

- Page 5, lines 14 - 20.
- Page 15, line 4 - page 16, line 12. (This shows that the airline, or third party, gains no control when the printing is done.)

Applicant points out that the Specification is interpreted by a person skilled-in-the-art. Such a person would see that:

- The Specification states that control is never passed to the third party. (Page 17.)
- The Specification states that the airline (a "third party") can request a message to be printed by a peripheral. (Page 16.)
- The Specification provides an example of printing by a third party, wherein the third party follows pre-arranged procedures. (Page 15, line 24 - page 16, line 12.) This is a peer-to-peer process. (Page 16, line 4.)

Applicant submits that this supports the claim language in question, to a person skilled in the art. Specifically, it shows that

- The third party gains no control over the peripheral (eg, printer) when a request is made to the peripheral, and when the peripheral is actuated. And since granting of the request is discussed, no control is given

09/691,553  
Art Unit 2154  
Docket 8673

at that time either.

-- The terminal application activates the peripheral. (Page 8, line 13; Figure 9; and page 15, lines 9 - 12.)

-- The user obtains the "service" (the printing) via the peripheral.

#### CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,



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